

REMARKS

Applicants respectfully acknowledge receipt of the Final Office Action mailed July 18, 2006.

In the Final Office Action, the Examiner objected to claim 7, rejected claims 1, 2, 4, and 9* under 35 U.S.C. § 102(b) as being anticipated by *Shaddock* (U.S. Patent Pub. No. 2002/0163001); and rejected claims 6, 7, and 10-14 under 35 U.S.C. § 103(a) as being unpatentable over *Shaddock* in view of *Hsu* (U.S. Patent Pub. No. 2004/0000727).

By this Amendment, Applicants amend claim 1 and cancel claim 7, without prejudice of disclaimer. Upon entry of this amendment, claims 1-4, 6, and 9-14 will remain pending in this application. Of these claims, claims 1 and 10 are independent. Claims 5 and 8 were previously canceled in the Amendment filed May 11, 2006.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to claim 1. No new matter has been introduced.

Applicants traverse the objection and rejections above and respectfully request reconsideration for at least the reasons that follow.

I. CLAIM OBJECTION

Claim 7 stands objected to as allegedly "lack[ing] antecedent basis." (*Final Office Action*, p. 2, II. 3-4). The Examiner's objection to claim 7 has been rendered moot by the cancellation of that claim. Applicants therefore request that the objection to claim 7 be withdrawn.

*Applicants note that the Examiner has failed to examine claim 3. Since claim 3 is dependent on independent claim 1, Applicants presume that the Examiner intended to reject claim 3 under 35 U.S.C. § 102(b) as being anticipated by *Shaddock*. Applicants respectfully request that the Examiner clarify this discrepancy in the following communication.

II. 35 U.S.C. § 102 REJECTION

Claims 1, 2, 4, and 9 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Shaddock*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that amended independent claim 1 is patentably distinguishable over *Shaddock* at least for the reasons described below.

In order to properly establish that *Shaddock* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.” See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Shaddock appears to disclose a surface mount light emitting device package 10 including a reflector cup 14 and leads 16 and 18, a light emitting device 20 situated within the reflector cup 14 and coupled to the leads 16 and 18, and an encapsulant 22 disposed around the light emitting device and around the reflector cup 14. (*Shaddock*, para [0011] and FIG. 3)

As admitted by the Examiner, however, “*Shaddock* does not teach where the base protrudes from another pair of sides.” (*Final Office Action*, p. 4, ll. 14-15).

Accordingly, with respect to independent claim 1, *Shaddock* fails to teach or suggest Applicants' claimed combination, including, *inter alia*:

“wherein the base protrudes from a middle portion to a bottom surface and two other side surfaces of the optoelectronic component” (emphasis added).

Since *Shaddock* fails to disclose each and every element of independent claim 1, *Shaddock* fails to anticipate claim 1, and claims 2, 4, and 9 that depend from claim 1. Applicants therefore request that the rejection of claims 1, 2, 4, and 9 under 35 U.S.C. § 102(b) be withdrawn.

III. 35 U.S.C. § 103(a) REJECTION

Claims 6, 7, and 10-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shaddock* in view of *Hsu*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that independent claim 10 is patentably distinguishable over *Shaddock* and *Hsu* at least for the reasons described below. With respect to claim 7, Applicants submit the Examiner's rejection has been rendered moot by the cancellation of that claim.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant's disclosure." See M.P.E.P. §2143, 8th ed., February 2003.

As discussed above, *Shaddock* appears to disclose a surface mount light emitting device package 10 including a reflector cup 14 and leads 16 and 18, a light emitting device 20 situated within the reflector cup 14 and coupled to the leads 16 and

18, and an encapsulant 22 disposed around the light emitting device and around the reflector cup 14. (*Shaddock*, para [0011] and FIG. 3)

However, as admitted by the Examiner, *Shaddock*, at least, does not explicitly disclose “where the base protrudes from another pair of sides.” (*Final Office Action*, p. 4, II. 14-15).

To cure the deficiencies of *Shaddock*, the Examiner relies on *Hsu* and alleges “*Hsu* teaches an array of encapsulated LEDs (see figs. 4-6). *Hsu* further teaches the base material protrudes from all four sides (see eg. fig. 10 and 12). *Hsu* further teaches this allows easy manufacture of arbitrary cells (see abstract).” (*Id.* at p. 4, II. 16-19).

Hsu appears to illustrate an LED package 60, which includes a first terminal 70, a second terminal 80, an encapsulant 50, a base 51, an extending arm 18, and a separate arm 19. (*Hsu*, para [0025] and FIG. 12). The extending arm 18 and the separate arm 19, however, do not protrude out of the base 51 and the LED package 60 (emphasis added). The extending arm 18 and the separate arm 19 are level and even with the side surfaces of the base 51.

Accordingly, with respect to independent claim 10, *Shaddock* and *Hsu* fail to teach or suggest the claimed combination, including, *inter alia*:

“wherein the electrically conductive frame protrudes from a middle portion to two other side surfaces of the housing” (emphases added).

The Examiner has therefore not met at least one of the essential criteria for establishing a *prima facie* case of obviousness, wherein “the prior art reference (or references when combined) must teach or suggest all the claim limitations.” See M.P.E.P. §§ 2142, 2143, and 2143.03. Accordingly, independent claim 10, and

corresponding dependent claims 11-14, are patentable over *Shaddock* and *Hsu*. Claim 6 is allowable at least due to its dependence from independent claim 1 for reasons described above. Applicants therefore request that the rejection of claims 6, 7, and 10-14 under 35 U.S.C. § 103(a) be withdrawn.

IV. CONCLUSION

Applicants respectfully submit that claims 1-4, 6, and 9-14 are in condition for allowance.

The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 12, 2007

By: /David W. Hill/
David W. Hill
Reg. No. 28,220